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REMARKS

1. Applicant thanks the Examiner for pointing out the allowable subject matter of claim 7.

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2. **35 U.S.C. § 112**

Claims 6, 28 and 44 stand rejected under 35 U.S.C. § 112, 2nd paragraph for failing to particularly point out and distinctly claim the subject matter of the invention. Applicant amends the cited claims to correct the defects observed. Therefore the present rejection is deemed overcome.

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3. **35 U.S.C. § 102**

Claims 1, 6, 8-29, and 48 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 5,598,470 ("Cooper"). While Applicant respectfully disagrees with at least some of the Examiner's findings regarding claims 1, 6, 8-29 and 48, claim 1 has been cancelled from the Application. Accordingly, the rejection of claim 1 as being anticipated by Cooper is deemed overcome. New claim 52, incorporating the subject matter of claims 1 and 7, found to be allowable, has been added to the application. The dependent claims have been amended to correct their dependencies, in view of the cancellation of claim 1. The dependent claims, in view of their dependence from an allowable parent are deemed to be allowable without any separate consideration of their merits. No new matter is added by way of new claim 52.

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25 The above amendments are made in the interest of advancing prosecution of the application. They do not signify Applicant's agreement with the Examiner's position; nor do they signify an intention by applicant to sacrifice claim scope. Applicant expressly reserves the right to pursue patent protection of a scope it reasonably believes it is entitled to in one or more continuing applications.

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4. **35 U.S.C. § 103**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or
5 suggest all the claim limitations. MPEP § 2143.

Claims 3-5, 31-44 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper in view of Hurley. While the present rejection is overcome by the cancellation of claims 1 and 7 and the addition of new claim 52, Applicant has the following remarks regarding the rejection.

10 Claim 31: There is no teaching or suggestion in the combination of Cooper and Hurley of "wherein said notifier comprises means for notifying said prospective user to download said driver executable from said server." The Examiner has already admitted that the component from Cooper, the file management program, which the Examiner relies on as teaching "a driver
15 executable" is provided as part of the software package, not separately. The cited teaching from Hurley adds nothing. It merely states that software can be downloaded from the Internet. The Examiner points to nothing in the combination that teaches or suggests that a notifier from a previously acquired software package instructs the user to download a driver executable
20 from a server. Therefore, the present finding is improper.

Claim 32: As in claim 31, the driver executable is a utility acquired separately from the software package, while the Examiner has previously established that Cooper's file management program is acquired as part of the package.
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Claim 33-44: In view of the foregoing remarks regarding claims 30-32, the rejections of each of these claims is deemed improper.

Claim 49: The Examiner relies on Cooper, col. 10, lines 32-39 as teaching
30 "wherein said server inserts transaction information in said software product as a watermark." Applicant respectfully disagrees. While Cooper does teach provision of the permanent key, the permanent key is a separate object from the software. It is notoriously well known that a watermark is inseparably incorporated directly into the software. The Examiner will say that the

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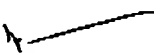
watermark and the permanent key both serve the same function, and are therefore not patentably distinct. Even if it is true that the two elements perform the same function, there is ample legal precedent that establishes that an invention that performs a known operation or function in a way different from the prior art can be both novel and non-obvious. Even if the claims had not been amended, the present rejection of claim 49 would therefore be improper.

Claims 45-47 stand rejected as being unpatentable over Cooper in view of U.S. patent no. 6,006,328 ("Drake"). In view of cancellation of claims 1 and 7 and the addition of new claim 52 to the application, the present rejection is deemed overcome.

CONCLUSION

For the foregoing reasons, the claims in the present application are patentably distinguished over the cited reference. Accordingly, all claims should be allowed without delay. Should the Examiner have any questions related to the application, he is urged to contact applicant's attorney at (650) 474-8400.

Respectfully submitted,


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